REMARKS

Claims 1-14, 19, 36, 47, and 58 were pending in the subject application. By this Amendment, applicants have canceled claims 1-14, 19, 36, 47, and 58, without disclaimer or prejudice, and added new claims 166-173. Accordingly, upon entry of this Amendment, claims 166-173 will be pending and under examination.

Applicants maintain that new claims 166-173 raise no issue of new matter.

Support for new claims 166-167 may be found inter alia in the specification, as originally-filed, at page 60, lines 1-23; page 44, lines 7-13; page 89, lines 8-9; and page 68, line 31-36. Support for new claims 168-169 may be found inter alia in the specification, as originally-filed, at page 61, line 9 through page 62, line 36; page 44, lines 7-13; page 89, lines 8-9; and page 68, line 31-36. Support for new claims 170-171 may be found inter alia in the specification, as originally-filed, at page 51, line 31 through page 54, line 19; page 44, lines 7-13; page 89, lines 8-9; and page 68, line 31-36. Support for new claims 172-173 may be found inter alia in the specification, as originally-filed, at page 65, line 3 through page 66, line 28; page 44, lines 7-13; page 89, lines 8-9; and page 68, line 31-36.

Accordingly, applicants respectfully request that the amendment be entered.

Restriction Requirement Under 35 U.S.C. §121

On page 2 of the November 17, 2003 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following inventions:

I. Claims 1-3, 5, 6, 8, 12, 19 and 36, drawn to nucleic acids encoding a human DNORF36a receptor of SEQ ID NO:2 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1;

II. Claims 1-3, 5, 7, 9, 13 and 19, drawn to nucleic acids encoding a human SNORF36b receptor of SEQ ID NO:4 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1;

III. Claims 1-3, 5, 7, 9, 13 and 19, drawn to nucleic acids encoding a rat SNORF36 receptor of SEQ ID NO:8 and vector comprising the nucleic acids, classified in class 536, subclass 23.4 and class 435, subclass 302.1;

IV. Claim 4, drawn to human SNORF36 genomic DNA, classified in class 536, subclass 23.5;

V. Claim 4, drawn to rat SNORF36 genomic DNA, classified in class 536, subclass 23.5;

VI. Claim 47, drawn to an antibody capable of binding to a human SNORF36a receptor of SEQ ID NO:2, classified in class 530, subclass 388.22, for example;

VII. Claim 47, drawn to an antibody capable of binding to a human SNORF36b receptor of SEQ ID NO:4, classified in class 530, subclass 388.22, for example;

VIII. Claim 47, drawn to an antibody capable of binding to a

rat SNORF36 receptor of SEQ ID NO:8, classified in class 530, subclass 388.22, for example;

IX. Claim 58, drawn to nonhuman mammal comprising a homologous recombination knockout of the native mammalian SNORF36a receptor, classified in class 800, subclass 8.

The Examiner alleged that the inventions are distinct. The Examiner alleged that inventions I and II are related in that they appear to be allelic or splice variants of each other, however, because there appears to be significant diversity between the two nucleic acids, separate searched would be required.

The Examiner then alleged that inventions I and II are both related to invention III because inventions I and II are human SNORF36 receptors and invention III is rat SNORF36, and therefore the rat receptor is an ortholog which requires a separate sequence search.

The Examiner further alleged that inventions I and II are related to invention IV in that invention IV is the genomic DNA corresponding to human SNORF36, and therefore the genomic sequence requires different considerations to determine patentability.

The Examiner alleged that invention III is related to invention V in that invention V is the genomic DNA corresponding to rat SNORF36, and therefore this genomic sequence also requires different considerations to determine patentability.

The Examiner also alleged that inventions I and II are related to

invention V in that inventions I and II are the human cDNAs encoding SNORF36 proteins, while the nucleic acid of invention V is the genomic DNA corresponding to rat SNORF36. The Examiner then alleged that invention III is related to invention IV in that invention III is the cDNA encoding rat SNORF36, while invention IV is the human genomic DNA. The Examiner alleged that genomic and cDNA sequences have different DNA sequences and different physical and functional characteristics, which would require different searches and consideration.

The Examiner also alleged that inventions IV and V, drawn to human and rat SNORF36 genomic DNA, respectively, are orthologs and would also require separate sequence searches.

The Examiner alleged that inventions VI-VIII, which are drawn to antibodies to human SNORF36a, 36b or rat SNORF36 proteins, respectively, cover antibodies that would probably cross-react with other proteins. The Examiner then alleged that due to the sequence differences between human SNORF36a, 36b and rat SNORF36 proteins, antibodies that bind to one protein may not bind to the other proteins, therefore the inventions would require a separate search.

The Examiner further alleged that each of inventions I-V are related to each of inventions VI-IX because the nucleic acids of inventions I-V are physically and functionally distinct chemical entities from those of the antibodies or transgenic animal of inventions VI-IX, and have different structures and activities. Finally, the Examiner alleged that each of inventions VI-VII are unrelated to invention IX because the antibodies are physically and functionally distinct entities from that of a transgenic animal.

The Examiner advised applicants that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

In response to this restriction requirement, applicants have canceled, without disclaimer or prejudice, claims 1-14, 19, 36, 47, and 58 which inventions I-IX are drawn upon, thereby rendering this restriction requirement moot.

Applicants, by this Amendment, have added new claims 166-173. Applicants maintain that claims 166-173 define a single inventive concept and respectfully request that the Examiner examine new claims 166-173, now pending in this application, on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed fee of $540.00 (which includes $110.00 for a one-month extension of time and $430.00 for additional claims fee), is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

1/20/04

John P. White
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Date